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In re Application of: Susumu Nakagawa )  
Application No. 09/878,581 )  
Attorney Docket No. 450100-03278 )  
Filed: June 11, 2001 )  
For: IMAGE CONTENT AND )  
ADVERTISEMENT DATA PROVIDING )  
METHOD, SYSTEM AND APPARATUS )

**DECISION ON PETITION TO  
WITHDRAW RESTRICTION  
REQUIREMENT UNDER 37 CFR  
§1.144**

This is a decision on the petition filed August 04, 2008 under 37 C.F.R. §1.144 and 37 C.F.R. §1.181 to withdraw an outstanding restriction requirement.

The petition is **GRANTED**.

**RELEVANT PROSECUTION HISTORY**

May 20, 2005	A restriction requirement of subcombinations useable together grouping claims 1-22 and 28-30 in one group and in the second group claims 23-27 and 31 was mailed out.
June 13, 2005	A response to the restriction requirement electing claims 1-22 and 28-30 without traverse was the filed by petitioner.
May 22, 2008	A second restriction requirement was mailed out with claims 1-9, 18, 20, 28 and 32-36 in group I, claims 10-17, 19, 22, 30 and 37 in group II and claims 21 and 29 in group III. Again, subcombinations useable together was the reason.
July 17, 2008	A second restriction requirement was made final.
August 1, 2008	A petition was filed asking for the restriction to be withdrawn as it is improper and claims 1-22, 28-30 and 32-37 be examined.

## **REGULATIONS AND PRACTICE**

### **37 C.F.R. § 1.143 states:**

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

### **37 C.F.R. § 1.144 states:**

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

### **37 C.F.R. § 1.145 states:**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

### **37 C.F.R. § 1.181 states:**

- (a) Petition may be taken to the Commissioner:
  - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
  - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
  - (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.
- (b) Any such petition must contain a statement of the facts involved and the point or

points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02....

MPEP § 821.01 states:

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

### **DECISION**

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner. 37 C.F.R. § 1.144 states that the applicant may petition the Commissioner after a final requirement for the restriction has been made.

In the above-identified application, applicant filed a request for reconsideration prior to the petition of August 1, 2008, in accordance with 37 C.F.R. § 1.143.

The issue presented in the petition is whether the restriction based on original presentation under 37 C.F.R. § 1.145 is proper under the current regulations and practice.

MPEP § 803 sets forth two criteria for a proper restriction requirement between patentably distinct inventions: (A) the inventions must be independent or distinct as claimed and (B) there must be a serious burden on the examiner.

Thus, to be proper, (A) current claims 1-22, 28-30 and 32-37 should be a distinct inventions; specifically, group I (claims 1-9, 18, 20, 28 and 32-36) drawn to inserting advertising image in image content, group II (claims 10-17, 19 22, 30 and 37) drawn to providing image content in it's entirety and then inserting advertisements and group III drawn to advertisement logging system must be patentably distinct inventions, and (B) there must be a serious burden on the examiner to search and consider these additional features beyond the search and consideration required for the original claims.

Since the insertion of advertisements into image content obviously includes short or entire image content based on the desire of a viewer or content provider, then groups I and II listed in the second restriction requirement are not distinct.

Further, since the insertion of advertisements (groups I and II) and the advertisement logging system (group III) have already been searched and considered (see original claims 1-22 and 28-30) then there would be no serious additional burden on the examiner to consider these features.

For the above reasons, the petition is **GRANTED**.

The restriction requirement is hereby **WITHDRAWN**.

The application will be forwarded to the examiner for consideration on the merits of claims 1-22, 28-30 and 32-37.

/Christopher Grant/

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